

DOCKET NO.: MSFT-0135 / 147325.1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT

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MAY 08 2003

GROUP 3600

re application of:

Marcus Peinado et al.

Serial No.: 09/525,510

Group Art Unit: 3621

Filing Date: March 15, 2000

Examiner: Firmin Backer

For: **RELEASING DECRYPTED DIGITAL CONTENT TO AN AUTHENTICATED
PATH**

I, Steven H. Meyer, Registration No. 37,189 certify that this correspondence is being deposited with the U.S. Postal Service as First Class mail in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231 on April 28, 2003.

Registration No: 37,189

Assistant Commissioner
for Patents
Washington, D.C. 20231

Dear Sir:

REQUEST FOR RECONSIDERATION AFTER FINAL

The following Request for Reconsideration After Final is submitted in response to the Final Office Action issued on January 29, 2003 (Paper No. 7) in connection with the above-identified patent application, and is being filed within the three-month shortened statutory period set for a response by the Final Office Action.

Claims 1-46 are pending in the present application, and stand finally rejected. Applicants respectfully request reconsideration and withdrawal of the final rejection of the claims, consistent with the following remarks.

The Examiner has again rejected claims 1-46 under 35 USC § 102(e) as being anticipated by Matsuzaki et al. (U.S. Patent No. 6,058,476). Applicants again respectfully traverse the § 102(e) rejection of such claims.

Independent claim 1 recites a method for releasing digital content to a rendering application, where the rendering application forwards the digital content to an ultimate destination by way of a path therebetween. Significantly, the path is defined by at least one module and the digital content is initially in an encrypted form.

In the method, an authentication of at least a portion of the path is performed to determine whether each defining module thereof is to be trusted to appropriately handle the digital content passing therethrough. If in fact each such defining module is to be trusted **based on the authentication**, the encrypted digital content is decrypted and forwarded to the rendering application for further forwarding to the ultimate destination by way of the authenticated path.

Independent claim 24 recites substantially the same subject matter as claim 1, albeit as a computer-readable medium having computer-executable instructions thereon that perform the method.

With the present invention, then, encrypted content is decrypted and released to a rendering application **only after** an authentication determines that trust may be imparted to the path that the rendering application will employ to forward the

decrypted content to the ultimate destination. **That is, the present invention requires (1) an authentication and then (2) a decryption and forwarding, but only if the authentication succeeds.** For example, in the case of an audio rendering application that will forward decrypted and rendered audio to a speaker by way of a path including digital audio filters, the audio application will only be allowed to have such decrypted audio **after** it is determined that the filters in the path can be trusted to handle the decrypted audio in a trusted manner. Such trust is for example with regard to the fact that the filters in the path will not copy the decrypted audio for the benefit of a nefarious entity. Thus, the present invention is especially useful when the encrypted content is of a type that should not be copied in a decrypted form, such as for example the aforementioned audio content in the form of a musical selection, or video content such as a commercially available movie. As may be appreciated, in the course of being authenticated, a particular module may prove its trustworthiness by, for example, proffering a digital certificate issued by an entity that may itself be deemed to be trustworthy.

The present invention as recited in the claims also requires that the path be not merely a conduit between a source and a destination, but such a conduit with at least one module such as the aforementioned filter therein. Thus, the present invention is especially concerned with theft by way of the module(s) in the conduit, and not merely with theft directly from the conduit. Once again, as recited in the claims, the authentication is performed with regard to at least a portion of the path to determine

whether each defining module thereof is to be trusted to appropriately handle the digital content passing therethrough. Thus, the present invention can be employed to restrict the content to a particular path or a particular set of modules within a path.

As Applicants previously pointed out, the Matsuzaki reference discloses a method of encrypting content for transmission between a first and a second device, where the first device encrypts the content and then transmits same to the second device in the encrypted form for decryption thereby. Accordingly, the Matsuzaki reference does not disclose decrypting the encrypted digital content and forwarding such decrypted content to a rendering application (the first device, according to the Examiner), for further forwarding to an ultimate destination (the second device, according to the Examiner) by a path, as is required by claims 1 and 24. More particularly, rather than transmitting decrypted content on a trusted path between the first and second devices, the Matsuzaki reference discloses that the path need not be trusted because the content is encrypted while traversing such path.

In the Response to Arguments section of the Final Office Action, the Examiner points to five clauses from claim 29 of the Matsuzaki reference in an attempt to show decrypted content being forwarded from the first Matsuzaki device ("communications device") to the second ("device in communication"):

- first receiving means for receiving challenge data from the device in communication;
- decryption means for decrypting the received challenge data;
- separation means for separating the decrypted challenge data into a first separated data which corresponds

to response data, and a remaining second separated data to be used for the data transfer key;

second transmission means for returning the first separated data to the device in communication as response data;

second receiving means for receiving response data returned from the device in communication;

However, and significantly, Applicants respectfully point out that such five clauses show that the second device sends challenge data to the first device, that the first device decrypts the challenge data and separates same into response data and a key, and that the first device sends the response data back to the second device.

Thus, and **as may be appreciated from the specification of the Matsuzaki reference**, the clauses represent the first Matsuzaki device **authenticating** itself to the second Matsuzaki device, and **not** the first Matsuzaki device sending decrypted content to the second Matsuzaki device over an **authenticated** path, as is required by claims 1 and 24.

Moreover, and critically, Matsuzaki claim 29 specifically requires in the preamble thereof that the key sent to the first device be used “to perform **encrypted** communication with the [second] device . . .” (emphasis added). Thus, Matsuzaki claim 29 specifically requires sending **encrypted** content from the first device to the second device **after** authenticating the second device.

Put another way, claims 1 and 24 require both **authenticating a path** and **sending decrypted content over the authenticated path**. Matsuzaki claim 29, in

contrast, discloses **authenticating a destination or source and sending / receiving encrypted content to / from the authenticated destination or source.**

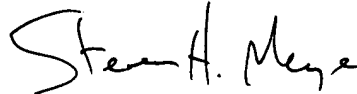
Further, and at any rate, although the Examiner again points to a cable 116 as defining the path and a SCSI controller 121 as defining a module in the path, neither such SCSI controller 121 nor any other module of such path between the first device and the second device in the Matsuzaki reference is authenticated to determine whether such module is to be trusted to appropriately handle any such decrypted digital content passing therethrough, as is required by claims 1 and 24. **Significantly, in the Response to Arguments, the Examiner has not even attempted to point out how any supposed module in a path between the first and second Matsuzaki devices is authenticated.**

Quite simply, the Matsuzaki reference teaches only that the first and second devices authenticate **each other, and not the path therebetween.** Moreover, and again, the Matsuzaki reference would **not** teach that either of the first and second devices authenticates the path therebetween for the reason that **the content traversing such path is encrypted.** Thus, the Matsuzaki path need not be authenticated for the reason that **such Matsuzaki path need not be trusted.**

Accordingly, and for all the aforementioned reasons, Applicants again respectfully submit that the Matsuzaki reference does not anticipate claims 1 or 24, or any claims depending therefrom, including claims 2-23 and 25-46. Thus, Applicants again respectfully request reconsideration and withdrawal of the § 102(e) rejection.

In view of the foregoing discussion, Applicants respectfully submit that the present application, including claims 1-46, is in condition for allowance, and such action is respectfully requested. Should the Examiner disagree, Applicants respectfully request that the Examiner telephone the undersigned at the number below to arrange an in-person interview with the Examiner and the Examiner's supervisor to discuss the present Office Action, and also respectfully request that such in-person interview be held promptly so that a Notice of Appeal may be filed in an expeditious manner if need be.

Respectfully submitted,



Steven H. Meyer
Registration No. 37,189

Date: April 28, 2003

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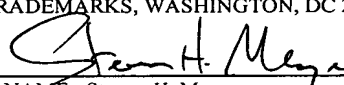
Confirmation No.: 9494

Group Art Unit: 3621

Examiner: Firmin Backer

DATE OF DEPOSIT: April 28, 2003

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TYPED NAME: Steven H. Meyer
REGISTRATION NO.: 37,189

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☒ AF

Assistant Commissioner for Patents
Washington DC 20231

Sir:

REPLY TRANSMITTAL LETTER

Transmitted herewith for filing in the above-identified patent application is:

- ☐ A Preliminary Amendment.
- ☒ A Request for Reconsideration Responsive to the Office Action Dated January 29, 2003.
- ☐ An Amendment Supplemental to the Paper filed
- ☐ Other: .
- ☐ Applicant(s) has previously claimed small entity status under 37 CFR § 1.27.

- ☐ Applicant(s) by its/their undersigned attorney, claims small entity status under 37 CFR § 1.27 as:
- ☐ an Independent Inventor
 - ☐ a Small Business Concern
 - ☐ a Nonprofit Organization
- ☐ This application is no longer entitled to small entity status. It is requested that this be noted in the files of the U.S. Patent and Trademark Office.
- ☐ Loss of Entitlement Enclosed
- ☐ Substitute Pages of the Specification are enclosed.
- ☐ An Abstract is enclosed.
- ☐ Sheets of Proposed Corrected Drawings are enclosed.
- ☐ A Certified Copy of each of the following applications: is enclosed.
- ☐ An Associate Power of Attorney is enclosed.
- ☐ Information Disclosure Statement.
- ☐ Attached Form 1449.
 - ☐ A copy of each reference as listed on the attached Form PTO-1449 is enclosed herewith.
- ☐ Appended Material as follows: .
- ☐ Other Material as follows: .

FEE CALCULATION

☒ No Additional Fee is Due.

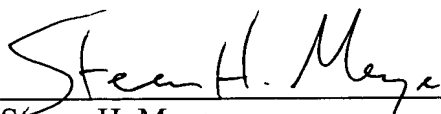
				SMALL ENTITY		NOT SMALL ENTITY	
	REMAINING AFTER AMENDMENT	HIGHEST PAID FOR	EXTRA	RATE	FEE	RATE	FEE
TOTAL CLAIMS	46	(20 MINIMUM)	0	\$9 EACH	\$	\$18 EACH	\$
INDEP. CLAIMS	2	3	0	\$42 EACH	\$	\$84 EACH	\$
FIRST PRESENTATION OF MULTIPLE DEPENDENT				\$140	\$	\$280	\$
<input type="checkbox"/> ONE MONTH EXTENSION OF TIME				\$55	\$	\$110	\$
<input type="checkbox"/> TWO MONTH EXTENSION OF TIME				\$205	\$	\$410	\$
<input type="checkbox"/> THREE MONTH EXTENSION OF TIME				\$465	\$	\$930	\$
<input type="checkbox"/> FOUR MONTH EXTENSION OF TIME				\$725	\$	\$1450	\$
<input type="checkbox"/> FIVE MONTH EXTENSION OF TIME				\$985	\$	\$1970	\$
<input type="checkbox"/> LESS ANY EXTENSION FEE ALREADY PAID				minus	(\$)	minus	(\$)
<input type="checkbox"/> TERMINAL DISCLAIMER				\$55	\$	\$110	\$
<input type="checkbox"/> OTHER FEE OR SURCHARGE AS FOLLOWS:							
TOTAL FEE DUE					\$		\$-0-

- ☐ A check in the amount of \$.00 is attached. Please charge any deficiency or credit any overpayment to Deposit Account 23-3050.
- ☐ Petition is hereby made under 37 CFR § 1.136(a) (fees: 37 CFR § 1.17(a)(1)-(4) to extend the time for response to the Office Action of _____ to and through _____ comprising an extension of the shortened statutory period of _____ month(s).
- ☒ The Commissioner is hereby requested to grant an extension of time for the appropriate length of time, should one be necessary, in connection with this filing or any future filing submitted to the U.S. Patent and Trademark Office in the above-identified application during the pendency of this application. The Commissioner is further authorized to charge any fees related to any such extension of time to Deposit Account 23-3050. This sheet is provided in duplicate.
- ☒ The Commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 23-3050. This sheet is provided in duplicate.
- ☐ The foregoing amount due for filing this paper.
- ☒ Any additional filing fees required, including fees for the presentation of extra claims under 37 CFR § 1.16.

☒ Any additional patent application processing fees under 37 CFR § 1.17 or 1.20(d).

SHOULD ANY DEFICIENCIES APPEAR with respect to this application, including deficiencies in payment of fees, missing parts of the application or otherwise, the U.S. Patent and Trademark Office is respectfully requested to promptly notify the undersigned.

Date: April 28, 2003


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